In reference to claims 1 and 19-21, Gonzales teaches an interactive publishing system for providing content management. Gonzales teaches a browser-based publishing tool allows a user to create a document that includes a hyperlink enabling a person viewing the document to navigate from a first point in the document to a second point in the document, or further to another document. See page 1, paragraph [0007]. Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Compare to **"embedding one or more links in the first portion referencing one or more external documents"** and **"embedding one or more links in the third portion referencing information contained in the second portion"**.

Applicant respectfully traverses the assertion. Gonzales relates to an World Wide Web publishing system for managing content of an article. Paragraph 7 of Gonzales states: "A typical browser-based publishing tool allows a user to create a document that includes a hyperlink enabling a person viewing the document to navigate from a first point in the document to a second point in the document, or further, to another document. In a case where a first document is being viewed on a web site, the hyperlink may provide a link to a second document on a different web site."

First, Applicant notes that the invention is not about a web page with hyperlinks to external documents, but about a portable electronic document descriptive of a particular intellectual property having three portions and wherein the third portion whose scope is interpreted based on the second portion. In one exemplary embodiment recited in claim 6, the electronic document can be a patent or a patent application and the first portion comprises a prior art section, the second portion comprises a description section, and the third portion comprises a claim section, the document cross-references an element in the claim section against one or more references to the element in the

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specification section. In another embodiment exemplified by claim 14, the intellectual property can be a patent document such as a patent or a patent application and wherein the first portion comprises a prior art section, the second portion comprises a description section, and the third portion comprises a claim section, further comprising cross-referencing an element in the claim section against one or more references to the element in the one or more related external documents.

The Office Action further asserts that:

> Gonzales does not expressly teach the one or more external documents are "viewable using a viewer application"; although he does teach viewing the documents via a browser. Sweet teaches retrieving documents linked to an initial document. Sweet teaches in response to a request from a user, a PDF viewer may retrieve from one or more web servers an initial document specified by a URL and other documents which are linked to the initial document. See column 8, lines 26-50. The PDF document is displayed by the PDF viewer. See column 8, lines 26-50. Compare to "documents viewable using a viewer application". It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide a viewer application to view documents referenced in Gonzales' system because it was desirable to provide a means to convert a semantic markup representation of a document into a physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display data to be stored as a single document, having a fixed page size. See columns 3-4 of Sweet.

Applicant also traverses this assertion. Sweet relates to techniques for displaying hypertext data, including displaying a first document represented in a physical markup representation and containing at least one hypertext link and, in response to a user input selecting a first hypertext link in the first document, accessing an external document represented in a semantic markup representation, the first hypertext link having an original state pointing to the external document. The semantic markup representation of the external document is converted into a physical markup representation and incorporated into the first document. A digest of the external document can be created

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and used to determine whether the physical markup representation of the external document has already been incorporated into the first document. Sweet allows Web pages written in a semantic markup language, such as HTML, to be integrated into a single paginated document described in a physical markup language, such as PDF. Web pages and which can be converted to a format having fixed page dimensions, without losing information because of space constraints. All of the documents which are linked to a document and also in the same directory path can be retrieved from a file system.

Sweet thus describes a system to incorporate user selected Web page links into a single integrated PDF document. However, Gonzales in view of Sweet fails to describe an electronic intellectual property document having first, second and third portions. Further, Gonzales points in the opposite direction in that Gonzales does not show embedding one or more links in the first portion referencing one or more external documents viewable using a viewer application. Additionally, Gonzales fails to show embedding one or more links in the third portion referencing information contained in the second portion.

As to the remaining dependent claims, these claims depend from allowable independent claims and thus the dependent claims are allowable. Moreover, the combination fails to teach the recited claims. Neither Gonzales nor Sweet shows claim 6, wherein the electronic document comprises a patent or a patent application and wherein the first portion comprises a prior art section, the second portion comprises a description section, and the third portion comprises a claim section, comprising cross-referencing an element in the claim section against one or more references to the element in the specification section, claim 7's cross-referencing the element in the claim section against

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one or more references to the element in the one or more external documents, claim 8's

visualizing one or more claims in a tree view, claim 9's drilling down details of each

claim in the tree view, claim10's retrieving a file history for the patent or the patent

application and cross-referencing the element in the claim section against one or more

references to the element in the file history, claim 11's cross-referencing the element

against equivalent terminology for the element in the specification section or in the one or

more external documents, claim 12's searching a database for related external documents,

claim 13's database being located on the Internet, claim 14's wherein the electronic

document comprises a patent or a patent application and wherein the first portion

comprises a prior art section, the second portion comprises a description section, and the

third portion comprises a claim section, further comprising cross-referencing an element

in the claim section against one or more references to the element in the one or more

related external documents, or claim 15's mapping intellectual property for an industry

covered by the patent or the patent application. The combination suggested by the

Examiner is done using hindsight as follows:

> In reference to claim 5, Gonzales does not teach retrieving one or more
> pages of an external document referenced by a link and consolidating all pages
> into the external document; however, Sweet does. Sweet teaches a web page
> integrator which is a part of a PDF viewer. The PDF viewer may request the
> integrator to retrieve from one or more web servers, an initial document specified
> by a URL supplied by the user or other documents which are linked, directly or
> indirectly, to the initial document. When the documents are retrieved, the web
> page integrator integrates them into a single PDF document which is then
> displayed by the PDF viewer. See column 8, lines 26-41. It would have been
> obvious to a person of ordinary skill in the art at the time of the invention to
> consolidate all pages into the external document because it was desirable to
> provide a means to convert a semantic markup representation of a document into
> a physical markup representation of the document (i.e. PDF) as it provides a
> common and convenient way for display data to be stored as a single document,
> having a fixed page size. See columns 3-4 of Sweet.

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In reference to claim 6, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to claim 7, Gonzales teaches a web page (i.e. document) includes areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a claim section; however, the claim section is merely a paragraph of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to claim 10, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that

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the text depicted a the claim of a patent application and file history because a claim and file history are simply text.

In reference to claim 12, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to claims 13-14, Gonzales teaches a database contains data relating to articles and documents that are developed by the users of system over the Internet. See pages 2, paragraph [0040] and page 3, paragraphs [0045].

In reference to first claim 15, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to second claim 15, Gonzales teaches the document comprises text. This text could be related to a patent application or patent. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

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The combination suggested by the Office Action was done using hindsight using the teachings of the present invention, and even with hindsight, the combination results in an inoperative device that does not

Claims 8-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales in view of Sweet et al, and further in view of Foqel et al., US 2004/0059994. Foquel relates to a method for checking semantic and syntactical correctness of patent claims. The method first checks for sequential claims numbering. For each claim a type and dependency are determined and the dependencies are checked for type match. Each claim is then parsed and checked for syntactical correctness and for correct antecedent basis for all its terms.

There is no suggestion to combine Gonzales with a portable document where the first portion comprises a prior art section, the second portion comprises a description section, and the third portion comprises a claim section, comprising cross-referencing an element in the claim section against one or more references to the element in the specification section and where one or more claims are visualized in a tree view. Similarly, there is no suggestion where the document supports drilling down details of each claim in the tree view.

Claims 16-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales in view of Sweet et al., and further in view of Mahoney et al., US 5,999,664. Claim 18 was rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales, in view of Sweet et al., and further in view of Barqeron et al., US 2004/0205542 Al, 10/14/04. The Office Action noted that

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In reference to claims 16-17, Gonzales/Sweet do not disclose using OCR from an image of the page and associating text with the corresponding location of the text in the image; however, Mahoney does. Mahoney teaches it was well known at the time of the invention to utilize OCR for search and retrieval of a document image. OCR distinguishes each bitmap of a character from its neighbor, analyzes the appearance, and distinguishes it from other characters in a predetermined set of characters. See page 3, lines5-51. Mahoney further teaches scanned images may be represented as PDF documents. See column 1, lines 34-40. It would have been obvious to a person of ordinary skill in the art at the time of the invention to enable searching a document using OCR in a PDF document as it was desirable at the time of the invention to search for a document stored in a large database particularly hardcopy documents that are scanned as images having no structural definition as it would not be perceivable by a computer, thus there was a need to analyze image data and pixels to help identify a document stored in a large corpus of documents. See columns 1-2 of Mahoney.

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In reference to claim 18, Gonzales/Sweet do not teach saving user annotations in the document; however, Bargeron does. Bargeron teaches the anchoring of annotations to content. On page 1, paragraph [0005], Bargeron discloses an annotation is associated with a particular portion of content. It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate Bargeron's annotation in the document in the system of Gonzales/Sweet as it was desirable to provide a means to preserve the annotations in a digital document because digital documents are easily and frequently altered, thereby changing the portion of the document to which the annotation corresponds. It would thus be beneficial to provide a way to improve the manner in which annotations are associated with portions of documents so that the annotations are still associated with the correct portion of the document despite alterations to the underlying content. See page 1, paragraph [0004].

Again, these claims are allowable as they depend from allowable independent claim. Further, there is no suggestion to combine.

CONCLUSION

Please charge any required small entity fees to Deposit Account 503398.

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,

By: _____

Bao Tran
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